

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks.

Telephone Interview Summary and Request

Applicant appreciates that courtesies extended on March 18 and 22 by Examiner Castro, and on April 1, 2010 by Examiner Castro and SPE Koenig, and further greatly appreciates their willingness to cooperate toward advancing prosecution of the present application.

During the interview of April 1, 2010 the Examiners agreed that they understand the logic of the arguments presented below with regard to the Flickinger and the Florencia references of record and agree that the claims overcome that combination. Further searching will be conducted upon submission of the present amendment.

Applicant respectfully requests the courtesy of a further interview after the Examiner has completed additional searching in order to expedite prosecution of the present application. The undersigned can be reached at the telephone number below.

Regarding the Rejections under 35 USC 112

Applicants appreciate the Examiner's notation of the antecedent basis issue with claim 1 and has amended this claim and others to clarify and eliminate any potential for misunderstanding as well as to correct the antecedent basis issues and place the application in better condition for appeal. Other clarifying amendments have also been made in the claims in order to place the claims in better condition for appeal. Claims 26 and 27 have been cancelled to simplify the issues for appeal, but Applicants reserve the right to present these claims or similar claims in a continuation application. Reconsideration and allowance are respectfully requested.

Regarding the Rejections under 35 USC 103(a)

Applicant again appreciates the Examiner's detailed explanation of the response to the arguments presented in the last Office Action response. Applicant reiterates all arguments

previously presented which remain relevant to the current rejections by reference and believe that they remain applicable.

Regarding all rejections, as the Examiner is aware in *Graham v. John Deere*, 383 U. S. 1 (1966), the Supreme Court set out a framework for applying the statutory language of §103 in making an objective analysis of obviousness. The Court stated that “under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Thus, it is noted that in order to establish *prima facie* obviousness, the Office must establish the scope and content of the prior art in order to meet the requirements set out in the *Graham v. Deere*. In so doing, the Office must identify each element claimed.

In each of the rejections presented in the present Office Action, the Office seeks to combine the Flickinger reference with the Florencio reference. While the combination is used in connection with other references for some of the rejections, the present remarks address the shortcomings of each of these two references and are applicable to each of the various reference combinations since the shortcomings noted have not been alleged to be met by any of the other references. In other words, the present arguments are directed at a failure of individual references to disclose that which they are asserted to disclose in order to establish that the overall combinations fail to establish *prima facie* obviousness.

As has been previously noted, while it is known that separate PIDs are used for separate television programs, use of PIDs as disclosed and claimed to identify substitute macroblocks of substitute content is neither taught nor suggested by any of the cited art singly or in combination. To provide a more rigorous interpretation of the conventional use of a PID, the undersigned submits herewith as evidence Table 3.1 and pages 21-25 of the text PSIP: Program and System Information Protocol by Mark K. Eyer. Mr. Eyer is an employee of an assignee of the present application. He is considered to be one of the world’s leading authorities on the topic of digital video and digital television, and is heavily involved in standards bodies for various aspects of digital video technology. This text is widely considered the authoritative text on many aspects of digital television. As will be seen from this evidence, a PID is conventionally used “to identify

and associate TS packets with particular Elementary Streams or SI/PSI data in the multiplex” of a digital television signal. From this, we can clearly determine that the conventional usage of a PID is for identifying 1) Elementary Streams (audio or video streams); 2) system information (SI); or 3) Program Specific Information (PSI).

Flickinger at [0077] is relatively consistent with Eyer in utilizing PIDs to either identify an advertisement or a “program stream” of advertisements. While programming content and associated advertisements normally are represented by a single set of PIDs, the discussion in Flickinger is reasonably consistent with Eyer if one considers an advertisement to be a television program or if one considers a program stream of advertisements to be a viable construct for a television program. However, it is submitted that it is a dramatic and non-obvious departure from this teaching to utilize a PID to identify a collection of substitute content that forms only selected macroblocks of video data that is otherwise not useful on its own until substituted into original content in place of original macroblocks (to paraphrase without intent of further limiting the actual claim language).

In Flickinger, full advertisements are inserted into a content stream using AD_IDs and ad resource locators (ARL) to represent the advertisements in full. These ads are spliced into the content at a designated time. There is also a very short disclosure that each ad could have a separate PID in paragraph [0077], but little disclosure as to the use of such PID and absolutely no teaching that the PID could represent only one or more macroblocks of substitute content as claimed.

In paragraph [0041], Flickinger asserts that his system can be used to insert ads into a portion of the screen, but Applicants are unable to determine how this might be done. Flickinger asserts that this is commercially available, but provides no enablement or description as to how it is done. The Office has furthermore failed to produce evidence supporting this position in the absence of actual disclosure in Flickinger. Hence, it is submitted that in the absence of an enabling disclosure, Flickinger fails to provide an adequate disclosure for rejection and certainly fails to adequately teach or suggest association of a collection of substitute macroblocks forming only a part of an image with its own separate PID.

It is further noted that the Office in fact admits that Flickinger fails to disclose that each PID is associated with one or more macroblocks of original content (e.g., page 5 of the current Office Action). The Florencia reference is alleged to teach this aspect. In view of the claim amendments, Applicants will interpret this allegation to mean that Florencio teaches identification of a collection of substitute macroblocks of less than full frames with a PID. The basic disclosure relied upon by the Office for this teaching is between col. 3, line 42 and col. 4, line 10 and the abstract of Florencia. However, Florencia explicitly states at col. 3, lines 52-53 that the implementation of the transcoder is a “conventional MPEG transcoder”. A careful review of this passage and the reference in total reveals that there is no such teaching present at these locations or elsewhere for assignment of a PID to identify a collection of substitute macroblocks as claimed. Rather, the reference provides a basic discussion of the composition of a digital video image in terms of macroblocks and slices and indicates that a logo can be combined with the main image by manipulation of the data in certain macroblocks. This is accomplished as depicted in Figs. 5-11, which involve determination that there is overlap between the logo and a particular macroblock and then decoding the macroblock. Then, the logo is added to the affected macroblocks and they are re-encoded. This process is followed by another encoding and decoding operation to adjust the size of the bit stream. There is no teaching of use of PIDs to identify substitute macroblocks that make up less than a frame. It is submitted that there is no particular need as best the undersigned can determine to use separate PIDs since the point where the logo is applied to the video stream is at a broadcast station for example (see e.g., col. 1, lines 20-23) where the raw logo data can, for example, reside permanently in a fixed memory for ease of access. No articulated reasoning has been presented based on the evidence that would support any need under the circumstances for one to use a PID to identify such data since it obviously can be stored locally without need for the PID identification.

In contrast, the claimed embodiments detect that a selection criterion is met and replaces a substitute macroblock for an original macroblock, where the substitute macroblocks are identified by a separate PID used for the substitute content (to paraphrase without intent of imposing additional limitations).

In view of the above, it is submitted that there is no teaching or suggestion in the cited art of “a second PID ... associated with substitute content, and where the substitute content comprises one or more substitute macroblocks of content but constitutes less than an entire frame of macroblocks”. It is submitted that use of a PID in this manner is non-obvious and inconsistent with standard MPEG usage of PIDs (again noting that Florencio is using standard MPEG as evidenced by the use of a “conventional MPEG decoder”). Hence, since neither reference teaches this and the assertion that it is taught in Florencio is in error, the combination fails as used alone or in combination with other references to meet all claim features. Since all claim features must be identified in the cited art in order to establish *prima facie* obviousness, the Office has erred in establishing *prima facie* obviousness. In view of the above, including the interview summary, the claims distinguish over the cited art. Reconsideration and allowance of the claims as amended is respectfully requested.

In addition, it is noted that the Office is apparently utilizing the reasoning of MPEP 2143 to combine or modify the references to obtain predictable results. However, the Office has failed in its burden to provide all of the elements necessary for a finding of obviousness since the rejections have failed to actually identify each claim element, namely by way of example, those relating to identifying the substitute macroblocks (less than a frame) with a second PID.

Additionally, there has been no finding that the individual claim elements function as they are known to function in the art. In fact, it has been established by the submitted evidence, that in fact the use of PIDs as taught by Applicants renders the PIDs to operate in a manner different than that known in the art since they are not used in the intended manner of the MPEG specification (per Eyer).

Finally, there must be a finding that one of ordinary skill in the art could have combined the elements to arrive at a predictable result, but Applicants submit that the findings are inadequate for such a conclusion and no such finding has been presented.

In view of all of the above, all claims are submitted to be allowable and reconsideration and allowance are respectfully requested.

The Office is further respectfully reminded that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (MPEP § 2143.01, VI citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Further, “[i]f [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (MPEP § 2143.01, V citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), emphasis added).

Hence, if one uses a second PID to identify anything other than those items normally identified by PIDs, the operation of the systems of the prior art which operate according to MPEG standards will likely not function properly, but at the very least the principle of operation will change since the standard MPEG usage of PIDs is modified in a manner that is not to the knowledge of the undersigned contemplated by the MPEG specifications. Hence, it is submitted that the proposed combination is further improper and inadequate to establish obviousness.

While the above does not individually address each rejection to each claim in detail, it is believed adequate to establish that all of the present rejections are improper by way of the Flickinger and Florencio references failure to identify the claim features asserted to be identified. In view of the present filing of an RCE, the interviews with the Examiner and the presentation of significantly amended claims, further discussion is believed unnecessary. The undersigned looks forward to discussion of this application further with the Examiner and advancing the prosecution of this application to allowance. All claims are believed to be in condition for allowance and such is respectfully requested at an early date.

The undersigned additionally notes that many distinctions exist between the cited art and the claims. However, in view of the deficiencies discussed above, further discussion is believed to be unnecessary at this time. Failure to address each point raised in the Final Office Action should accordingly not be viewed as accession to the Examiner’s position or an admission of any sort as to the correctness of the Office’s position regarding any matter.

No amendment made herein was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim unless an argument has been made herein that such amendment has been made to distinguish over a particular reference or combination of references.

Respectfully submitted,

/Jerry A. Miller 30779/

Jerry A. Miller
Registration No. 30,779
Dated: April 1, 2010

Please Send Correspondence to:
Miller Patent Services
2500 Dockery Lane
Raleigh, NC 27606
Phone: (919) 816-9981
Fax: (919) 816-9982
Customer Number 24337